

REMARKS:

1. Summary of the Rejections in the Office Action of November 2, 2004

At paragraph 3, on page 2 of the Office Action, the Examiner rejects claims 1-3, 7-11, and 15-17 under 35 U.S.C. § 102(e), as allegedly being anticipated by U.S. Patent No. 6,671,718 to Meister. At paragraph 10, on page 4 of the Office Action, the Examiner rejects claims 4-6, 12-14, and 18-20, under 35 U.S.C. § 103(a), as allegedly being obvious in view of Meister and U.S. Patent No. 6,252,588 to Dawson.

2. 35 U.S.C. § 102(e) Rejections

At paragraph 3, on page 2 of the Office Action, the Examiner rejects claims 1-3, 7-11, and 15-17 under 35 U.S.C. § 102(e), as allegedly being anticipated by Meister.

The Applicant respectfully TRAVERSES the Examiner's anticipation rejections and asserts the following remarks in response.

The Applicant has amended independent claims 1, 9, and 15 to incorporate the limitations of original dependent claims 4, 12, and 18, respectively. At paragraph 11, on page 4 of the Office Action, the Examiner acknowledges that Dawson does not disclose or suggest the limitations of original claims 4, 12, or 18. Therefore, the Applicant respectfully requests that the Examiner withdraw the anticipation rejection of independent claims 1, 9, and 15.

Claims 2, 3, 7, 8, 10, 11, 16, and 17 depend from independent claims 1, 9, and 15, respectively. Therefore, the Applicant respectfully requests that the Examiner also withdraw the anticipation rejection of claims 2, 3, 7, 8, 10, 11, 16, and 17.

3. **35 U.S.C. § 103(a) Rejections**

At paragraph 10, on page 4 of the Office Action, the Examiner rejects claims 4-6, 12-14, and 18-20, under 35 U.S.C. § 103(a), as allegedly being obvious in view of Meister and Dawson.

The Applicant respectfully TRAVERSES the Examiner's rejections and asserts the following remarks in response.

In order for the Examiner to establish a prima facie case for obviousness, three (3) criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the primary reference as the Examiner proposes. Second, there must be a reasonable expectation of success in connection with the Examiner's proposed combination of the references. And third, the prior art references must disclose or suggest all of the claim limitations. MPEP 2143 (emphasis added.) The Applicant maintains that the Examiner fails to satisfy his burden of establishing a prima facie case for obviousness because the Examiner fails to show that the combination of Meister and Dawson discloses or suggests all of the claimed limitations of claims 4-6, 12-14, and 18-20.

a. **Independent Claims 1, 9, and 15**

The Applicant has amended independent claims 1, 9, and 15 to incorporate the limitations of original dependent claims 4, 12, and 18, respectively. Therefore, the Applicant has addressed the obviousness rejection of original, dependent claims 4, 12, and 18 in view of amended independent claims 1, 9, and 15.

The Applicant has amended independent claim 1 to recite, in part: “confirmation means for confirming that said email message is to be sent to said specified recipient by presenting to said sender a confirmation notice, said confirmation notice requesting said sender to confirm that said specified recipient is an intended recipient of said email message, **wherein said confirmation means includes a picture presentation facility, said picture presentation facility configured to present to said sender a picture of said specified recipient.**” Similarly, the Applicant has amended independent claim 9 to recite, in part: “a confirmation facility configured to confirm that said email message is to be sent to said specified recipient by presenting to said sender a confirmation notice, said confirmation notice requesting said sender to confirm that said specified recipient is an intended recipient of said email message, **wherein said confirmation facility includes a picture presentation facility, said picture presentation facility configured to present to said sender a picture of said specified recipient.**” Moreover, the Applicant has amended independent claim 15 to recite, in part: “confirming that said email message is to be sent to said specified recipient by presenting to said sender a confirmation notice, said confirmation notice requesting said sender to confirm that said specified recipient is an intended recipient of said email message, **wherein said confirmation notice includes a picture of said specified recipient.**”

At paragraph 11, on page 4 of the Office Action, the Examiner acknowledges that Dawson does not disclose or suggest the above-bolded limitations of independent claims 1, 9, and 15. However, the Examiner asserts that Dawson supplies these missing limitations. The Applicant respectfully disagrees.

For example, Dawson states:

[t]he SET UP RECIPIENT PICTURES AND E-MAIL ADDRESSES screen 1701 of one embodiment of the invention is shown in FIG. 17. As shown in FIG. 17, screen 1701 is divided into two portions, an upper portion 1702 and a lower portion 1704. Upper portion 1702 displays a column of recipient text entry fields for e-mail addresses and associated thumbnail pictures. In FIG. 17 thumbnail 1729 is associated with the e-mail address in text entry field 1731. Thumbnail 1729 together with the e-mail address in text entry field 1731 form a thumbnail/address combination. Thumbnail 1725 is associated with the e-mail address in text entry field 1727, forming a second thumbnail/address combination. Thumbnail 1721 is associated with the address in text entry field 1723, forming a third thumbnail/address combination. Thumbnail space in 1703 is blank, as is the associated text entry field 1718. The next address that is added to the address book will be inserted into the text entry field 1718, and it will be associated with the thumbnail that will be inserted into thumbnail space 1703. If there are more recipient thumbnail and address combinations than can be displayed on the screen at one time, a scrolling mechanism may be used.

Dawson, Column 25, Lines 51-68; and Column 26, Lines 1-5. Thus, Dawson merely describes that a thumbnail may be associated with a recipient e-mail address, and when a user wishes to compose an e-mail, instead of having to “select [an] e-mail address from a list of long and complex e-mail addresses,” the user instead may “select a thumbnail image of the intended recipient.” See, e.g., Dawson, Abstract, Lines 5-10.

Nevertheless, the combination of Meister and Dawson does not result in the Applicant’s claimed invention, as set forth in independent claims 1, 9, and 15. For example, Meister merely discloses providing a user an option to select a thumbnail instead of an e-mail address when the user wishes to compose an e-mail to send to a particular recipient. Thus, if the system described in Meister were modified to incorporate the thumbnail selection option described in Dawson, the result merely would be a system in which when a user wishes to compose an e-mail, the user could select the recipient’s image instead of having to select an e-mail address from a list of possible e-

mail addresses. However, because the system described in Dawson does not include any confirmation means or any confirmation facility, Dawson does not disclose or suggest modifying the confirmation facility/confirmation means described in Meister to include a picture presentation facility for presenting a picture of the recipient during confirmation of whether the user wishes to send the e-mail to the recipient, as set forth in the Applicant's independent claims 1, 9, and 15. Therefore, the Applicant respectfully requests that the Examiner allow independent claims 1, 9, and 15 to issue in a U.S. patent.

b. Dependent Claims 8-20

Claims 5, 6, 13, 14, 19, and 20 depend from allowable independent claims 1, 9, and 15, respectively. Therefore, the Applicant respectfully requests that the Examiner withdraw the obviousness rejection of claims 5, 6, 13, 14, 19, and 20 and allow the same to issue in a U.S. patent.

c. Dependent Claims 4, 12, and 18

The Applicant has canceled claims 4, 12, and 18, without prejudice to the subject matter claimed thereby. Therefore, the obviousness rejection of claims 4, 12, and 18 is rendered moot.

CONCLUSION:

The Applicant respectfully submits that the above-titled patent application is in condition for allowance, and such action is earnestly requested. If the Examiner believes that an in-person or telephonic interview with the Applicant's representatives will in any way expedite the examination of the above-titled patent application, the Examiner is invited to contact the undersigned attorney of record. The Applicant is including a check in the amount of \$60 covering the requisite small entity fee for a one-month extension of time to respond to the outstanding Office Action. Nevertheless, in the event of any variance between the fees determined by the Applicant and the fees determined by the U.S. Patent and Trademark Office, please charge or credit such variance to the undersigned's Deposit Account No. 01-2300.

Respectfully submitted,

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The PTO did not receive the following
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